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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,067	01/14/2004	Jonathan J. Hull	015358-004031US	5097
20350 7590 07/17/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
NGUYEN, MADELEINE ANH VINH				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,067

Applicant(s)

HULL ET AL.

Examiner

Madeleine AV Nguyen

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on April 03, 2008 have been fully considered but they are not persuasive for the following reasons.

A. Applicants remark that Freeman teaches that the archiving is automatic for documents stored to the system that are older than some date d" while Applicants' claims recite automatic unconscious archiving for each email message transmitted over the network. The archiving is done unconscious to the user, as the user does not have to save the email to a drive or do anything other than receive the email message.

Freeman teaches, "an operating system in which the location and nature of file storage is transparent to the user, for example, the storage of the files is handled automatically and file names are only used if a user chooses to invent such names." (paragraph 0012) and "an operating system in which archiving is automatic." (paragraph 0015). Thus, the claimed invention is read on Freeman since Freeman teaches the automatic unconscious archiving of email message since the location and nature of file storage is transparent to the user and the archiving is automatic (Abstract). It is noted that the claim does not mention when the email message is saved, thus, although Freeman teaches that the email message is saved after some amount of time d, the fact of automatic and unconscious archiving the email message taught in Freeman is still read on the claimed invention.

B. Applicants remark that the claims recite capturing "electronic document images of the plurality of email documents transferred over the network" and automatically and unconsciously

archiving the images of the email documents. In Freeman, the storing is for the actual file and not a captured image of the email document.

Freeman teaches that the documents are archived automatically wherein the location and nature of the file storage is transparent and the documents can include text, pictures, animations, software programs or any other type of data (Abstract). Freeman further teaches, "Every document created and every document send to a person or entity is stored in a main stream" (paragraph 0033) and the clone operation "duplicates an existing document and adds the duplicate document to the main stream" (paragraphs 0036). Furthermore, Freeman discloses, "The present invention allows a stream document to contain another stream that is a "stream envelope".... the stream envelope contains a copy of all the documents from the other stream." (paragraph 0065). That is equivalent to capturing "electronic document images" and automatically and unconsciously archiving the images of the email documents.

C. Applicants' claims recite "unconsciously capture archiving of electronic document images from at least one of a copy, print, and facsimile operation." while Freeman does not disclose automatically capturing data for copy, print or facsimile operations without user interaction, and certainly does not disclose automatically capturing and archiving an image of something that is simply printed or copied using a single user input command.

As stated above, Freeman teaches that the documents are archived automatically wherein the location and nature of the file storage is transparent and the documents can include text, pictures, animations, software programs or any other type of data (Abstract). In addition, "the electronic document can be accessed from multiple locations" (paragraph 0013), "each of the data units may be textual data, video data, audio data and/or multimedia data." (paragraph 0020),

the sub-stream will collect new documents that match the search criteria as documents arrive from outside the operating system or as the user creates the document.” (paragraph 0039) and “regarding the term “document”, it is noted that this term includes traditional text based files, electronic files, binary files, audio data, video data, and multimedia data.” (paragraph 0105). Freeman further teaches the search query such as “all E-mail I haven’t responded to” or “all faxes I haven’t sent to ... “ (paragraph 0037) and “Print button 80 copies a selected document to a printer where documents may be either printed conventionally or moved to a printer stream. Since the system in Freeman can connected to different networking system, to different servers, computers, devices such as printer, scanner, facsimile and multimedia devices, it can automatically capturing data for copy, print or facsimile operations and automatically archiving an image.

It is noted that the claims must be given their broadest reasonable interpretation. During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541m 550-51 (CCPA 1969).

Therefore, the rejection of claims 20-32 is maintained.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 20-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeman et al (US Publication No. 2007/0260980).

Concerning claims 1 and 25, Freeman et al discloses an email server for performing unconscious archiving of electronic documents in a network environment, wherein electronic documents are transferred over a network coupling at least one client computer and at least one document management workstation having at least one database disposed to receive electronic copies of said documents for archiving, the at least one document management workstation being in communication with at least one of a copy, print, and facsimile operation (Abstract; paragraphs 0012-0015, 0033-0037, 0046) said server operatively disposed to: collect electronic image data of each and every email document in a plurality of email documents transmitted over the network in response to a single user input command, the electronic image data being a copy of each and every email document transmitted over the network (40, 50 or 80, Fig.1; paragraphs 0036-0039, 0051-0052); cause said image data to be stored in the at least one database (paragraphs 0075-0076) to perform the unconscious capture archiving, wherein the at least one database further comprises image data from unconscious capture archiving of electronic document images from the at least one of a copy, print, and facsimile operation, wherein the aforementioned steps are carried out transparent to the user and without further input from the user notwithstanding the single user input command, and the aforementioned steps capture

electronic document images of the plurality of email documents transferred over the network (Fig.1; paragraphs 0012-0015, 0033, 0036-0039, 0046, 0051, 0065, 0075-0076, 0081, 0085-0087, 0096-0098, 0101-0105).

Concerning claim 21, Freeman et al further teaches the email server of claim 20, wherein the at least one of the copy, print, and facsimile operation comprises at least one of a copier operation, printer operation, and facsimile machine operation (40, 50 and 80, Fig.1) that archived image data for at least one of the copier operation, printer operation, and facsimile machine operation (paragraphs 0051, 0052, 0062-0065, 0075-0076, 0085-0086).

Claims 22 and 29 are method claims of apparatus claims 1 and 25. Claims 22 and 29 are rejected for the same rationales set forth for claims 1 and 25.

Concerning claim 23-24, 26-28 and 30-32, Freeman et al further teaches the method of claims 22 and 29, wherein causing the collected image data of every email to be stored comprises storing at least one of an origin address and destination address for an email (paragraphs 0096-0098), (claim 23); causing the collected image data of every email to be stored comprises storing at least one of a date of transmission and time of transmission for an email (Figs.4-5; Abstract; paragraphs 0001, 0033, 0034, 0036, 0058, 0072, 0086), (claim 24); the destination comprises a destination client system (paragraphs 0019, 0032, 0046-0047), (claims 26, 30); the email document comprises an email document that was at least one of received and sent (paragraphs 0037, 0038, 0051, 0085-0086, 0105), (claims 27 and 31); the at least one database is configured to store image data that was archived from at least a copier operation, a

printer operation and a facsimile machine operation (paragraphs 0051, 0052, 0062-0065, 0075-0076, 0085-0086), (claims 28, 32).

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Madeleine AV Nguyen/
Primary Examiner, Art Unit 2625

Madeleine AV Nguyen
Primary Examiner
Art Unit 2625

July 17, 2008